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REMARKS

With the entry of the present amendments, claims 2-7, 9-11, 13-15, 22 and 23 are pending in the application. Claims 2-7, 9-11, 13-15 and 22 have been amended. The amendments to claims 9, 10, 13 and 22 merely import the limitations of the cancelled claims from which claims 9, 10, 13 and 22 depend. The amendments to claims 2-7, 11, 14 and 15 merely amend the dependencies of these claims so they do not depend from cancelled claims. As such, these amendments require no more than a cursory review by the Examiner and their entry is respectfully requested. Claims 1, 8, 12, 16, 17, 21 and 24 have been cancelled. Claims 18-20 were cancelled in a previous response.

In view of the following remarks, reconsideration and withdrawal of the rejections to the application in the Office Action is respectfully requested.

Rejection of Claims under 35 U.S.C. § 112, second paragraph

The Examiner rejected claim 22 under 35 U.S.C. § 112, second paragraph stating the term "in an amount effective" in reference to the amount of dispersant in the composition is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicants respectfully traverse.

Applicants note that the term "effective amount" is not indefinite provided one of skill in the art could determine specific values for the amount based on the disclosure. (MPEP 2173.05(c)) The pending application provides sufficient guidance to allow one of skill in the art to determine what is meant by an "effective amount." For example, the discussion in paragraph 25 of the pending applications provides suggested ranges of 0.1 to 10 weight percent and preferably 0.25 to 2 weight percent for the dispersant. In addition Examples 1-3 in the specification each provide a working example that includes a specific value of an effective amount of dispersant in a surface restoration composition (i.e., ACUSOL 425N in amounts of 0.25 and 0.5 wt.%). Thus, Applicants respectfully assert that by using the guidance provided in the specification, one of skill in the art would be able to determine what is meant by "effect amount" in claim 22 and Applicants respectfully request that this rejection be withdrawn.

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Rejection of Claims under 35 U.S.C. § 102(b) over George et al.

Claims 1-8, 11-17, 21 and 22 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 4,738,876 ("George et al."). Although Applicants respectfully disagree with the Examiner's reasons for rejecting claims 1, 8, 12, 16, 17 and 21, these claims have been cancelled without prejudice to Applicants' right to prosecute these claims in a timely filed continuation application in order to facilitate the prosecution of the present application. Therefore, with respect to these claims the rejection has been rendered moot. Applicants respectfully traverse the rejection of claims 13 and 22.

Claims 13 and 22 recite a surface restoration composition that includes an organic acid, an inorganic metal oxide and a dispersant. The compositions of claim 13 further include a plasticizer. In the Office Action the Examiner stated that George et al. meets all of these limitations, citing column 3, lines 49-53 and column 5, lines 20-37 of George et al. However, Applicants were unable to find any mention of a dispersant in the cited passages. George et al. does teach a composition optionally containing a wax dispersion (col. 5, line 32). It is possible that the Examiner is suggesting that a dispersant would inherently be present in a wax dispersion. However Applicants note that a wax dispersion does not necessarily contain a dispersant. Applicants further note that in order for an element to be inherent in a reference, the missing element must necessarily result from the prior art reference. It is not enough that the element may result from a given set of circumstances. (MPEP 2112(IV)) The burden is on the Examiner to show that the missing element, in this case, a dispersant, must be present in the compositions of George et al. The Examiner has not offered any such evidence, and therefore has not made a *prima facie* case of anticipation with respect to claims 13 and 22. For this reason, Applicants respectfully request that this rejections of claims 13 and 22, and of claims 14 and 15 which now depend from claim 13, be withdrawn.

Rejection of Claims under 35 U.S.C. § 102(b) over Wirth et al.

Claims 21, 22 and 24 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 4,886,610 ("Wirth et al."). Although Applicants respectfully disagree with the Examiner's reasons for rejecting claims 21 and 24, these claims have been cancelled without prejudice to Applicants' right to prosecute these claims in a timely filed continuation application in order

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to facilitate the prosecution of the present application. Therefore, with respect to these claims the rejection has been rendered moot. Applicants respectfully traverse the rejection of claim 22.

Claim 22 recites a surface restoration composition containing an organic acid, a metal oxide and a dispersant present in an amount effective to minimize formation of crystals larger than 100Å. In rejecting claim 22 the Examiner stated that Wirth et al. meets all the claim limitations. (As discussed above, Applicants believe that the term "an effective amount" is rendered definite by the guidance provided in the specification.) The Examiner does not identify, and Applicants were unable to find, any language in Wirth et al. describing the amount of dispersant present in the compositions taught therein. Instead, Wirth et al. merely points out that a dispersant may be present (col. 4, lines 31-36). Therefore, Wirth et al. fails to teach each and every limitation of claim 22 and Applicants respectfully request that the rejection be withdrawn.

Rejection of Claims under 35 U.S.C. § 103(a) over George et al.

Claims 9, 10, 22 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over George et al. Claims 22 and 23 also were rejected under 35 U.S.C. § 103(a) as unpatentable over Wirth et al. Applicants respectfully traverse.

In support of this rejection of claims 9, 10 and 23 the Examiner stated that both George et al. and Wirth et al. disclose all of the limitations of the above claims, except for the size of the metal oxides. The Examiner further stated, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the specific sizes recited, e.g., 100 nanometer, since it has been held that where the general conditions of a claim are discussed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233." Applicants respectfully disagree.

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine optimization. (MPEP 2144.05(II)(B)). The Examiner has not identified, and Applicants have not found, any suggestion in either George et al. or Wirth et al. that the particle size of the metal oxide was recognized as a result-effective variable in those references. In fact, neither George et al. nor

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Wirth et al. mention particle size with respect to the metal oxides at all. Therefore, the identification of the claimed particle size ranges cannot be characterized as routine optimization and Applicants respectfully request that the rejection be withdrawn.

In support of the rejection of claim 22, the Examiner stated that both George et al. and Wirth et al. disclose all of the limitations of the claim except the amount of dispersant present. Although the Examiner does not explicitly state as much, the Examiner appears to be suggesting that it would have been obvious to one of skill in the art to use the amount of dispersant recited in claim 22, as a matter of routine optimization. As discussed previously with regard to the rejections under 35 U.S.C. § 102(b), Applicants note that George et al. does not actually disclose a composition containing a dispersant. Therefore, for the reasons stated above, Applicants again request that the rejection over George et al. be withdrawn. However, even assuming George et al. and Wirth et al. did each disclose the use of a dispersant, the amount of dispersant recited in claim 22 would not be rendered obvious by the teachings of those references.

Applicants note again that a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine optimization. (MPEP 2144.05(II)(B)). In the present invention, the inventor's discovered that the use an effective amount of dispersant could be used to achieve a recognized result, namely the minimization of calcium oxalate crystals larger than 100Å. This is important because it provides a surface restoring composition that fills the voids in a surface without sacrificing surface gloss. (See the discussion in paragraphs 24 and 25 of the pending application.) In contrast, there is no suggestion in either George et al. or Wirth et al. that the amount of dispersant (if any) present in the compositions disclosed therein was recognized as a result-effective variable. In fact, neither George et al. nor Wirth et al. provide any ranges or suggestions regarding the amount of dispersant present. Therefore, the identification of the claimed amount of dispersant in the present compositions cannot be characterized as routine optimization and Applicants respectfully request that the rejection of claim 22 be withdrawn.

In view of the foregoing remarks, Applicants respectfully submit that all of the claims remaining in the application are in condition for allowance and favorable action thereon is

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respectfully requested. If Examiner Shakeri has any questions, or believes a telephone discussion would expedite prosecution, Examiner Shakeri is invited to contact the undersigned at the telephone number listed below.

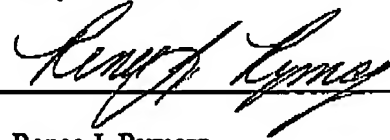
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Respectfully submitted,

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